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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Frampton E. ELLIS, III**

Serial No.: **09/527,019**

Group Art Unit: **3728**

Filed: **March 16, 2000**

Examiner: **Anthony Starink**

For: **REMOVABLE ROUNDED MIDSOLE STRUCTURES AND
CHAMBERS WITH COMPUTER CONTROLLED
PROCESSOR-CONTROLLED VARIABLE PRESSURE**

Certificate of Mailing

I hereby certify that this paper is being sent via First Class Mail to the Assistant Commissioner for Patents on the date shown below.

On September 23, 2003

John Schmitz

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

APPEAL BRIEF

This is an appeal from the Final Rejection dated April 23, 2003 (hereinafter "the Final Rejection"). Appellant respectfully submits that the Final Rejection was made in error, and should be reversed for the reasons set forth below.

I. The Real Party In Interest

The real party in interest is Anatomic Research, Inc., to whom an undivided interest in U.S. Application no. 09/527,019 - *Removable Rounded Midsole Structures and Chambers with*

Computer Controlled Processor-Controlled Variable Pressure - has been assigned by virtue of an assignment recorded on December 4, 2000 at reel 011382, frame 0085.

II. Related Appeals And Interferences

An appeal has been filed in co-pending U.S. application no. 09/558,629. This appeal may be related to the appeal in U.S. application no. 09/558/629 since there is both a same invention double patenting rejection and an obviousness-type double patenting rejection in the present application over U.S. application no. 09/558,629.

III. The Status Of The Claims

Claims 1-10 have been canceled without prejudice to resubmission.

Claims 11-44 are currently pending and stand rejected in a Final Office Action dated April 23, 2003. The rejection(s) of all of claims 11-44 are hereby appealed. A copy of the currently pending claims 11-44 is attached as an appendix hereto.

IV. The Status Of Any Amendments Filed After Final Rejection

No amendments were filed after the Final Rejection.

V. Summary Of The Invention

In a first aspect, as claimed in independent claim 11, the present invention relates to an inner shoe that forms part of an outer shoe and that is removable from the outer shoe such that the inner shoe can be worn independently of the outer shoe. The inner shoe includes a removable midsole section sized to fit inside and form part of the sole of an outer shoe that is designed to receive and retain the removable midsole section. The inner shoe also includes a secondary outer sole on at least a portion of the outer surface of the removable midsole section to provide traction or wear resistance when the inner shoe is worn without the outer shoe. The inner shoe also includes a device associated with the removable midsole section for retaining the inner shoe on

an intended wearer's foot when worn without the outer shoe. Additional features of this aspect of the invention are claimed in claims 12-22.

In a second aspect, as claimed in claim 23, the present invention relates to a shoe comprising a shoe upper and a shoe sole including at least a bottom sole. An inner shoe as claimed in claim 11 forms at least a portion of the shoe sole. At least a portion of the side of the shoe upper is attached directly to the bottom sole such that the shoe upper abuts at least a portion of the outer surface of the inner shoe when the inner shoe is inserted in the shoe. The inner shoe is removable from the shoe and insertable in the shoe through an opening in the shoe upper provided for entry and exit of the intended wearer's foot into and out of the shoe. Additional features of this aspect of the invention are claimed in claim 24

In a third aspect, as claimed in independent claim 25, the present invention relates to a removable midsole section, sized to fit inside a shoe and form part of a shoe designed to receive and retain the removable midsole section. The removable midsole section is removable from the shoe. The removable midsole section is defined by an inner surface and an outer surface and has a lateral side, a medial side and a middle portion located between the lateral and medial sides. The removable midsole section also includes a plurality of protrusions on at least one side of the removable midsole section that interact with the shoe to retain the removable midsole section in the shoe. At least a portion of the outer surface of each protrusion is concavely rounded relative to an inner section of the removable midsole section adjacent to the concavely rounded outer surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition. Each of the protrusions has an outer surface formed by midsole. At least one portion of an inner surface of a side of the removable midsole section is convexly rounded relative to a section of the removable midsole section directly adjacent to the convexly rounded inner surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition. Additional features of this aspect of the invention are claimed in claims 26-31.

In a fourth aspect, as claimed in claim 32, the present invention relates to a shoe comprising a shoe upper and a shoe sole including at least a bottom sole. An inner shoe as

claimed in claim 25 forms at least a portion of the shoe sole. At least a portion of the side of the shoe upper is attached directly to the bottom sole such that the shoe upper abuts at least a portion of the outer surface of the inner shoe when the inner shoe is inserted in the shoe. The inner shoe is removable from the shoe and insertable in the shoe through an opening in the shoe upper provided for entry and exit of the intended wearer's foot into and out of the shoe. Additional features of this aspect of the invention are claimed in claims 33-38.

In a fifth aspect, as claimed in independent claim 39, the present invention relates to a shoe for receiving a removable midsole section. The shoe includes a shoe upper and a shoe sole including at least a bottom sole. At least a portion of the side of the shoe upper is attached directly to the bottom sole such that the shoe upper abuts at least a portion of the outer surface of the removable midsole section when the removable midsole section is inserted into the shoe. The removable midsole section is removable from the shoe and insertable in the shoe through an opening in the shoe upper provided for entry and exit of the intended wearer's foot into and out of the shoe. The shoe also includes at least two recesses in the bottom sole to thereby releasably retain the removable midsole section in the shoe. Additional features of this aspect of the invention are claimed in claims 40-44.

The inner shoe has several additional characteristics claimed in various dependent claims including: (1) at least one computer controlled compartment located in an upper portion of the removable midsole section; (2) from a frontal cross-sectional view, at least a portion of the outer surface of a side of the removable midsole is concavely rounded relative to the corresponding inner section of the removable midsole; (3) at least a portion of the inner surface of a side of the removable midsole is convexly rounded relative to the corresponding outer section of the removable midsole, as viewed in a frontal plane cross-section; (4) the thickness of the concavely rounded sides taper when viewed from a horizontal plane; (5) the concavely rounded portions form a plurality of protrusions, in between which one or more indentations can occur; (6) one or more of these protrusions are located at one of the following parts of an intended wearer's foot: a base of a calcaneus, a lateral tuberosity of the calcaneus, a head of a first distal phalange, a longitudinal arch, a head of a first metatarsal, a head of a fifth metatarsal, and a base of the fifth

metatarsal. Moreover, when the inner shoe is inserted into the receiving shoe, at least a portion of the side of the shoe upper attaches directly to the bottom sole such that the shoe upper abuts at least a portion of the outer surface of the inner shoe.

The bottom sole of the receiving shoe may also have a plurality of tapering protrusions which are concavely rounded relative to an adjacent concavely rounded inner section, as viewed in a frontal plane cross-section. These protrusions are positioned to correspond to one of the following parts of an intended wearer's foot: a base of a calcaneus, a lateral tuberosity of the calcaneus, a head of a first distal phalange, a longitudinal arch, a head of a first metatarsal, a head of a fifth metatarsal, and a base of the fifth metatarsal.

VI. Issues On Appeal

Appellant believes that the various issues to be considered on appeal may be concisely summarized as follows:

Issue 1: Whether Claims 11, 14-20, 22, 25-31 and 39-44 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by WO 97/46127 (Adidas AG).

Issue 2: Whether Claims 25-26 and 32-38 are unpatentable under 35 U.S.C. § 103(a) over WO 97/46127 (Adidas AG) in view of U.S. Patent no. 5,425,186 (Hoyt).

Issue 3: Whether Claims 12-13 are unpatentable under 35 U.S.C. § 103(a) over WO 97/46127 (Adidas AG) in view of U.S. Patent no. 5,813,142 (Demon).

Issue 4: Whether Claim 21 is unpatentable under 35 U.S.C. § 103(a) over WO 97/46127 (Adidas AG) in view of U.S. Patent no. 6,023,857 (Vizy et al.).

Issue 5: Whether claims 11-44 claim the same invention as claims 11-45 of co-pending U.S. application no. 09/558,629 in violation of 35 U.S.C. §101.

Issue 6: Whether claims 11-44 are unpatentable over claims 11-45 of co-pending U.S. application no. 09/558,629 under the judicially-created doctrine of obviousness double patenting.

VII. Grouping Of Claims

Group I – Claims 11, 14-20 and 22

Group II – Claims 12-13

Group III – Claim 21

Group IV – Claim 23

Group V - Claims 25-31

Group VI – Claim 32

Group VII – Claims 33-38

Group VIII – Claims 39-44

VIII. Argument – The Rejection And Appellant's Response.

Issue 1: Whether Claims 11, 14-20, 22 and 25-31 and 39-44 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by WO 97/46127 (Adidas AG).

Group I – Claims 11, 14-20 and 22

Claims 11, 14-20 and 22 have been rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by International Publication no. WO 97/46127 (hereinafter “Adidas AG”).

The Adidas AG invention is a method for permanently assembling a shoe outer sole, midsole, upper, and toe piece. Despite the similarities between certain diagrams of Adidas AG and certain diagrams of the present application, Adidas AG does not teach or suggest a removable inner shoe or removable insert. Rather, Adidas AG teaches at page 12, lines 7-13 that,

“The outsole is then attached to the upper by a stitch 80 that weaves around the outer perimeter of the openings thereby connecting the upper 16 to the outsole flanges (e.g., flange 70 in Fig. 8) and the attachment surface 68 (in FIG. 6) of the

outsole. In addition, an adhesive can be applied to the attachment surface and/or the interior receiving surface of the upper before the outsole is inserted into the upper to provide an additional bond between the upper and the outsole."

Also, Adidas AG states at page 12, lines 14-22 that

"the midsole is then inserted into the interior cavity of the upper and affixed to the top side of the outsole ... An adhesive can be used on the bottom side of the midsole 12 to secure the midsole to the outsole. ... A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole to strengthen the bond between the midsole and the outsole ..."

Clearly the outsole is permanently attached to the upper and the midsole 12 is permanently affixed to the outsole and thus is not removable. Thus, Adidas AG does not teach the inner shoe as claimed in the present claims since the midsole 12 of Adidas AG is permanently attached to the outsole and thus is not a removable midsole section.

"Anticipation" under 35 U.S.C. § 102(b) is established only when single prior art reference discloses, expressly or under principles of inherency, each and every element of claimed invention. *See RCA Corp., supra.* Because Adidas AG does not teach or suggest the removable feature of the midsole section of the present invention, it clearly cannot anticipate any of claims 11, 14-20 and 22.

The Examiner takes the position at page 9, lines 1-2 of the Final Rejection that the adhesive for affixing the midsole to the outsole of Adidas AG is optional. This is correct, but only to the extent that instead of an adhesive, stitching can be employed. See page 13, lines 1-5 of Adidas AG. Either way, Adidas AG clearly teaches at page 12, lines 14-16 that, "the midsole is then inserted into the interior cavity of the upper and affixed to the top side of the outsole ..." (emphasis added) and thus whether or not the adhesive is optional does not change the fact that

the midsole is permanently affixed to the outsole in Adidas AG.

The Examiner also takes the position at page 9, lines 2-6 that the stitches of Adidas AG can be cut to remove the sole. There is no teaching or suggestion in Adidas AG of the desirability of cutting the stitches, as suggested by the Examiner, and thus Adidas AG does not teach a removable midsole section, as claimed. Moreover, this goes directly against the teaching of Adidas AG that the midsole section should be affixed to the outersole. Adidas AG also teaches that, "A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole to strengthen the bond between the midsole and the outsole ..." See page 12, lines 20-22 of Adidas AG. This teaching of Adidas AG indicates both that there is a bond between the midsole and the outersole, and that Adidas AG desires to make this a strong bond, by using the last 82 to strengthen the bond formed by the adhesive, stitching, or a combination of adhesive and stitching. Clearly, the desirability of a strong bond between the midsole and the outer sole of Adidas AG is the exact opposite of the midsole being removable, as required by the present claims. Thus, Adidas AG does not teach or suggest a removable midsole section, as claimed.

Finally, the Examiner takes the position that because the specification of the present application contemplates that there can be a releasable attachment between the removable midsole section and the outer sole, cutting the stitches holding the midsole to the outer sole in the Adidas AG reference meets the requirement of the present claims for a removable midsole section. This is clearly wrong since the cutting of the stitches of the shoe of Adidas AG requires the permanent destruction of the attachment means. This is totally different than the use of a releasable attachment as described in the present specification.

More specifically, The removable midsole section of the present invention may be releasably attached to the sole through one or a plurality of means, including, but not limited to, mechanical fasteners, snap fittings, adhesives, etc. It should be noted that a key property for each of these methods of attachment is releasability. That is, the method of attachment must not only hold the removable midsole section and shoe together, but also allow the removable midsole section and shoe to be separated without destroying either component. For example, if an adhesive were used as the method of attachment, the bonding capacity of the adhesive must be "tacky" (similar to the adhesive of a Post-It™ note) so that removable midsole section may be readily secured and released multiple times without causing damage to the removable midsole section, the adhesive or the shoe itself. The same is true of the mechanical fasteners, snap fittings, etc., namely, that removal of the removable midsole section does not damage the shoe in any way, i.e. the shoe is designed to permit repeated removal and reinsertion of the removable midsole section. This is clearly different from the shoe of Adidas AG where stitching or adhesives are employed for the purpose of permanently attaching the midsole to the outer sole.

Therefore, the Appellant respectfully requests that the rejection of Claims 11, 14-20 and 22 under 35 U.S.C. §102(b) as being anticipated by Adidas AG be reversed.

Group V – Claims 25-31

Claims 25-31 have been rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by WO 97/46127 (hereinafter “Adidas AG”). The Adidas AG invention is a method for permanently assembling a shoe outer sole, midsole, upper, and toe piece. Adidas AG does not teach or suggest a removable inner shoe or removable insert, as required by these claims.

Rather, Adidas AG teaches at page 12, lines 7-13 that,

"The outsole is then attached to the upper by a stitch 80 that weaves around the outer perimeter of the openings thereby connecting the upper 16 to the outsole flanges (e.g., flange 70 in Fig. 8) and the attachment surface 68 (in FIG. 6) of the outsole. In addition, an adhesive can be applied to the attachment surface and/or the interior receiving surface of the upper before the outsole is inserted into the upper to provide an additional bond between the upper and the outsole."

Also, Adidas AG states at page 12, lines 14-22 that,

"the midsole is then inserted into the interior cavity of the upper and affixed to the top side of the outsole ... An adhesive can be used on the bottom side of the midsole 12 to secure the midsole to the outsole. ... A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole to strengthen the bond between the midsole and the outsole ..."

Clearly the outsole is permanently attached to the upper and the midsole 12 is permanently affixed to the outsole and thus is not removable. Thus, Adidas AG does not teach the removable midsole section as claimed in claims 25-31 since the midsole 12 of Adidas AG is permanently attached to the outsole and thus does not include a removable midsole section.

"Anticipation" under 35 U.S.C. § 102(b) is established only when single prior art reference discloses, expressly or under principles of inherency, each and every element of claimed invention. *See RCA Corp., supra.* Because Adidas AG does not teach or suggest the removable feature of the midsole section of the present invention, it clearly cannot anticipate any of claims 25-31.

The Examiner takes the position at page 9, lines 1-2 of the Final Rejection that the adhesive for affixing the midsole to the outsole of Adidas AG is optional. This is correct, but only to the extent that instead of an adhesive, stitching can be employed. See page 13, lines 1-5 of Adidas AG. Either way, Adidas AG clearly teaches at page 12, lines 14-16 that, "the midsole

is then inserted into the interior cavity of the upper and affixed to the top side of the outsole ..." (emphasis added) and thus whether or not the adhesive is optional does not change the fact that the midsole is permanently affixed to the outsole in Adidas AG.

The Examiner also takes the position at page 9, lines 2-6 that the stitches of Adidas AG can be cut to remove the sole. There is no teaching or suggestion in Adidas AG of the desirability of cutting the stitches and thus Adidas AG does not teach a removable midsole section, as claimed. Moreover, this goes directly against the teaching of Adidas AG that the midsole section should be affixed to the outer sole. Adidas AG teaches that, "A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole to strengthen the bond between the midsole and the outsole ..." See page 12, lines 20-22 of Adidas AG. This statement indicates both that there is a bond between the midsole and the outersole, and that Adidas AG desires to make this a strong bond, by using the last 82 to strengthen the bond formed by the adhesive, stitching, or the combination of adhesive and stitching. Clearly, the desirability of a strong bond between the midsole and the outer sole of Adidas AG is the exact opposite of the midsole being removable, as required by the present claims. Thus, Adidas AG does not teach or suggest a removable midsole section, as claimed.

Finally, the Examiner takes the position that because the specification of the present application contemplates that there can be a releasable attachment between the removable midsole section and the outer sole, cutting the stitches holding the midsole to the outer sole in the Adidas AG reference meets the requirement of the present claims for a removable midsole section. This is clearly wrong since the cutting of the stitches of the shoe of Adidas AG requires

the permanent destruction of the attachment means. This is totally different than the use of a releasable attachment as described in the present specification.

More specifically, The removable midsole section of the present invention may be releasably attached to the sole through one or a plurality of means, including, but not limited to, mechanical fasteners, snap fittings, adhesives, etc. It should be noted that a key property for each of these methods of attachment is releasability. That is, the method of attachment must not only hold the removable midsole section and shoe together, but also allow the removable midsole section and shoe to be separated without destroying either component. For example, if an adhesive were used as the method of attachment, the bonding capacity of the adhesive must be "tacky" (similar to the adhesive of a Post-It™ note) so that removable midsole section may be readily secured and released multiple times without causing damage to the removable midsole section, the adhesive or the shoe itself. The same is true of the mechanical fasteners, snap fittings, etc., namely, that removal of the removable midsole section does not damage the shoe in any way, i.e. the shoe is designed to permit repeated removal and reinsertion of the removable midsole section. This is clearly different from the shoe of Adidas AG where stitching or adhesives are employed for the purpose of permanently attaching the midsole to the outer sole.

Therefore, the Appellant respectfully requests that the rejection of Claims 25-31 under 35 U.S.C. §102(b) as being anticipated by Adidas AG be reversed.

Group VIII – Claims 39-44

Claims 39-44 have been rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by WO 97/46127 (hereinafter “Adidas AG”). The Adidas AG invention is a method for permanently assembling a shoe outer sole, midsole, upper, and toe piece. Despite the similarities between certain diagrams of Adidas AG and certain diagrams of the present application, Adidas AG does not teach or suggest a removable inner shoe or removable insert. Rather, Adidas AG teaches at page 12, lines 7-13 that,

“The outsole is then attached to the upper by a stitch 80 that weaves around the outer perimeter of the openings thereby connecting the upper 16 to the outsole flanges (e.g., flange 70 in Fig. 8) and the attachment surface 68 (in FIG. 6) of the outsole. In addition, an adhesive can be applied to the attachment surface and/or the interior receiving surface of the upper before the outsole is inserted into the upper to provide an additional bond between the upper and the outsole.”

Also, Adidas AG states at page 12, lines 14-22 that,

“the midsole is then inserted into the interior cavity of the upper and affixed to the top side of the outsole ... An adhesive can be used on the bottom side of the midsole 12 to secure the midsole to the outsole. ... A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole to strengthen the bond between the midsole and the outsole ...”

Clearly the outsole is permanently attached to the upper and the midsole 12 is permanently affixed to the outsole and thus is not removable. Thus, Adidas AG does not teach the inner shoe as claimed in claims 39-44 since the midsole 12 of Adidas AG is permanently attached to the outsole and thus does not include a removable midsole section.

“Anticipation” under 35 U.S.C. § 102(b) is established only when single prior art reference discloses, expressly or under principles of inherency, each and every element of claimed invention. *See RCA Corp., supra.* Because Adidas AG does not teach or suggest the

removable feature of the midsole section of the present invention, it clearly cannot anticipate any of claims 39-44, since Adidas AG does not include at least two recesses in the bottom sole which releasably retain the removable midsole section in the outer shoe, as required by claims 39-44.

The Examiner alleges that the at least two recesses in the bottom sole required by claims 39-44 are formed by the inside of protrusions 62,64 and 66 in the bottom sole of Adidas AG. However, as discussed above, the midsole of Adidas AG is permanently attached to the bottom sole of Adidas AG and thus the structure relied on by the Examiner does not perform the claimed function of releasably retaining a removable midsole section, nor can it perform this function since the midsole is permanently attached to the bottom sole.

The Examiner takes the position at page 9, lines 1-2 of the Final Rejection that the adhesive for affixing the midsole to the outersole of Adidas AG is optional. This is correct, but only to the extent that instead of an adhesive, stitching can be employed. See page 13, lines 1-5 of Adidas AG. Either way, Adidas AG clearly teaches at page 12, lines 14-16 that, "the midsole is then inserted into the interior cavity of the upper and affixed to the top side of the outsole ..." (emphasis added) and thus whether or not the adhesive is optional does not change the fact that the midsole is permanently affixed to the outsole in Adidas AG.

The Examiner also takes the position at page 9, lines 2-6 that the stitches of Adidas AG can be cut to remove the sole. There is no teaching or suggestion in Adidas AG of the desirability of cutting the stitches and thus Adidas AG does not teach a removable midsole section, as claimed. Moreover, this goes directly against the teaching of Adidas AG that the midsole section should be affixed to the outer sole by adhesive or stitching, as discussed above.

Adidas AG teaches that, "A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole to strengthen the bond between the midsole and the outsole ..." See page 12, lines 20-22 of Adidas AG. This statement indicates both that there is a bond between the midsole and the outersole, and that Adidas AG desires to make this a strong bond, by using the last 82 to strengthen the bond formed by the adhesive, stitching, or the combination of adhesive and stitching. Clearly, the desirability of a strong bond between the midsole and the outer sole of Adidas AG is the exact opposite of the midsole being removable, as required by the present claims. Thus, Adidas AG does not teach or suggest a removable midsole section, as claimed. Thus, Adidas AG does not teach or suggest a removable midsole section, as claimed.

Finally, the Examiner takes the position that because the specification of the present application contemplates that there can be a releasable attachment between the removable midsole section and the outer sole, cutting the stitches holding the midsole to the outer sole in the Adidas AG reference meets the requirement of the present claims for a removable midsole section. This is clearly wrong since the cutting of the stitches of the shoe of Adidas AG requires the permanent destruction of the attachment means. This is totally different than the use of a releasable attachment as described in the present specification.

More specifically, The removable midsole section of the present invention may be releasably attached to the sole through one or a plurality of means, including, but not limited to, mechanical fasteners, snap fittings, adhesives, etc. It should be noted that a key property for each of these methods of attachment is releasability. That is, the method of attachment must not only hold the removable midsole section and shoe together, but also allow the removable midsole

section and shoe to be separated without destroying either component. For example, if an adhesive were used as the method of attachment, the bonding capacity of the adhesive must be "tacky" (similar to the adhesive of a Post-It™ note) so that removable midsole section may be readily secured and released multiple times without causing damage to the removable midsole section, the adhesive or the shoe itself. The same is true of the mechanical fasteners, snap fittings, etc., namely, that removal of the removable midsole section does not damage the shoe in any way, i.e. the shoe is designed to permit repeated removal and reinsertion of the removable midsole section. This is clearly different from the shoe of Adidas AG where stitching or adhesives are employed for the purpose of permanently attaching the midsole to the outer sole.

Therefore, the Appellant respectfully requests that the rejection of Claims 39-44 under 35 U.S.C. §102(b) as being anticipated by Adidas AG be reversed.

Issue 2: Whether Claims 25-26 and 32-38 are unpatentable under 35 U.S.C. § 103(a) over WO 97/46127 (Adidas AG) in view of U.S. Patent no. 5,425,186 (Hoyt).

Group V – Claims 25-26

The Examiner rejected claims 25-26 as unpatentable under 35 U.S.C. § 103(a) over Adidas AG in view of U.S. Patent no. 5,425,186 (Hoyt). In support of this rejection, the Examiner took the position that Adidas AG was to be applied to claims 25-26 as it was applied above in the anticipation rejection of claim 11, and thus concluded that Adidas AG teaches all limitations of claims 25-26 except for a shoe upper and a shoe sole. This statement by the

Examiner makes no sense in the context of a rejection of claims 25-26, however, since neither of claims 25-26 uses the terminology “shoe upper” or “shoe sole.”

The Examiner then relied on Hoyt as teaching that an overshoe, which consists of a shoe upper 32 and sole 12, 14, can cover a shoe. The Examiner then concluded that the overshoe of Hoyt can be placed over the shoe of Adidas AG to protect it from wear and tear as well as inclement weather. From this, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to place the shoe of Adidas AG in the overshoe of Hoyt in order to arrive at the present invention, as claimed in claims 25-26 and 32.

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and Citations omitted]

Applying this requirement, at least two features of claims 25-26 are not found in the Examiner’s combination of Adidas AG with Hoyt, namely, (1) the plurality of protrusions on at least one side of the removable midsole section that are sized to interact with the shoe to retain the removable midsole section in the shoe, and (2) that the outer surface of each of the plurality of protrusions must be formed by midsole.

There is no teaching or suggestion in either Adidas AG or Hoyt that the plurality of protrusions on at least one side of the removable midsole section interact with the shoe to retain the removable midsole section in the shoe. Specifically, according to the Examiner, the shoe of

claims 25-26 corresponds to the overshoe of Hoyt and the removable midsole section of claims 25-26 corresponds to the entire shoe of Adidas AG. Reviewing the references, it is clear that Adidas AG does not contemplate that its shoe would be inserted into an overshoe. Thus, the Examiner must rely on Hoyt for this teaching. However, Hoyt teaches that the overshoe should stretch in a longitudinal direction to fit each shoe. See col. 2, lines 48-51 of Hoyt. In fact, Hoyt provides a shoe sole with an accordion-like structure to facilitate longitudinal stretching. As a result, the overshoe of Hoyt would be retained on the shoe of Adidas AG by a combination of the portion of the upper that extends over the top of the forefoot area of the shoe and the tendency of the Hoyt overshoe to snugly fit over the toe and heel of the Adidas AG shoe due to it having to be stretched in the longitudinal direction to fit the Adidas AG shoe. Clearly neither of these ways of retaining the Hoyt overshoe on the Adidas AG shoe involve an interaction of protrusions on the side of the Adidas AG shoe with the Hoyt overshoe.

Hoyt does not specify how wide the Hoyt overshoe should be relative to any shoe that will be inserted within it. Thus, Hoyt does not teach or suggest that the side of the Adidas AG shoe should contact the Hoyt overshoe. Accordingly, the skilled person cannot derive this feature of claims 25-26 from a combination of Hoyt with Adidas AG.

The Examiner takes the position that, "As the overshoe of Hoyt is stretched, the sides of the upper of the overshoe more tightly fit and take on the shape of the shoe in [sic-over] which they are being stretched around [sic], thereby allowing the protrusions of the shoe of WO '612 [Adidas AG] to aid in holding the overshoe onto the shoe." While this could be true if Hoyt disclosed a specific relationship between the width of the overshoe and the shoe in which it was

to fit that would make this happen, Hoyt contains no such disclosure. Thus, this is mere speculation on the part of the Examiner. In fact, the teachings of Hoyt suggest that the exact opposite is true. In this regard, Hoyt contemplates that the overshoe can be stretched to accommodate shoes of several different sizes. See col. 2, lines 48-51 of Hoyt. Certainly, for the smaller sizes of these shoes of several different sizes, the sides of the Hoyt overshoe will not likely abut the outer surface of the shoe as the Examiner suggests, since relatively little stretching of the Hoyt overshoe would be required to accommodate the smaller sizes of the several different sizes that a particular Hoyt overshoe could be stretched to accommodate.

In addition, claims 25-26 require that the outer surface of the protrusions of the removable midsole section be formed by midsole. This limitation is also not taught or suggested by the combination of Adidas AG and Hoyt since the outer surface of the Adidas AG shoe, which, according to the Examiner, corresponds to the removable midsole section of claims 25-26, when contained in the Hoyt overshoe, is formed by either upper or bottom sole but not by midsole since the Adidas AG shoe has no outer surface formed by midsole. In other words, the midsole of Adidas AG is contained entirely within the upper and outsole of the Adidas AG shoe, and entirely within the Hoyt overshoe when the shoe of Adidas AG is in the Hoyt overshoe. As a result, the shoe of Adidas AG, when inserted in the overshoe of Hoyt as suggested by the Examiner, has no outer surface formed by midsole as claims 25-26 require. Thus, Adidas AG in combination with Hoyt does not teach or suggest this feature of claims 25-26 of the present application either.

With respect to this issue, the Examiner takes the position that the insertion of the Adidas

AG shoe into the overshoe of Hoyt somehow changes the outer sole of Adidas AG to midsole. See page 10, lines 4-13 of the Final Rejection. This argument is clearly wrong since it directly contradicts the teachings of Adidas AG that the outer sole is an outer sole and that a midsole is a separate element internal to the outer sole. Thus, this argument should be disregarded.

Therefore, since at least two elements of claims 25-26 are missing from a combination of Hoyt with Adidas AG, the Examiner has not made out a case of *prima facie* obviousness and thus the rejection of claims 25-26 under 35 U.S.C. §103(a) over a combination of Adidas AG and Hoyt should be reversed for at least these reasons.

Group VI – Claim 32

The Examiner rejected claim 32 as unpatentable under 35 U.S.C. § 103(a) over Adidas AG in view of U.S. Patent no. 5,425,186 (Hoyt). In support of this rejection, the Examiner took the position that Adidas AG was to be applied to claim 32, as it was applied to claim 25 above (i.e. presumably in the anticipation rejection of claim 25), and thus concluded that Adidas AG teaches all of the limitations of claim 32 except for a shoe upper and a shoe sole.

The Examiner then relied on Hoyt as teaching that an overshoe, which consists of a shoe upper 32 and sole 12, 14, can cover a shoe. The Examiner then concluded that the overshoe of Hoyt can be placed over the shoe of Adidas AG to protect it from wear and tear as well as inclement weather. From this, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to place the shoe of Adidas AG in the overshoe of Hoyt in order to arrive at the present invention, as claimed in claim 32.

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and Citations omitted]

Applying this requirement, at least two features of claims 25-26 are not found in the Examiner's combination of Adidas AG with Hoyt, namely, (1) the plurality of protrusions on at least one side of the removable midsole section that are sized to interact with the shoe to retain the removable midsole section in the shoe, and (2) that the outer surface of each of the plurality of protrusions must be formed by midsole.

There is no teaching or suggestion in either Adidas AG or Hoyt that the plurality of protrusions on at least one side of the removable midsole section interact with the shoe to retain the removable midsole section in the shoe. Specifically, according to the Examiner, the shoe of claim 32 corresponds to the overshoe of Hoyt and the removable midsole section of claim 32 corresponds to the entire shoe of Adidas AG. Reviewing the references, it is clear that Adidas AG does not contemplate that its shoe would be inserted into an overshoe. Thus, the Examiner must rely on Hoyt for this teaching. However, Hoyt teaches that the overshoe should stretch in a longitudinal direction to fit each shoe. See col. 2, lines 48-51 of Hoyt. In fact, Hoyt provides a shoe sole with an accordion-like structure to facilitate longitudinal stretching. As a result, the overshoe of Hoyt would be retained on the shoe of Adidas AG by a combination of the portion of the upper that extends over the top of the forefoot area of the shoe and the tendency of the Hoyt overshoe to snugly fit over the toe and heel of the Adidas AG shoe due to it having to be

stretched in the longitudinal direction to fit the Adidas AG shoe. Clearly neither of these ways of retaining the Hoyt overshoe on the Adidas AG shoe involve an interaction of protrusions on the side of the Adidas AG shoe with the Hoyt overshoe.

Hoyt does not specify how wide the Hoyt overshoe should be relative to any shoe that will be inserted within it. Thus, Hoyt does not teach or suggest that the side of the Adidas AG shoe should contact the Hoyt overshoe. Accordingly, the skilled person cannot derive this feature of claim 32 from a combination of Hoyt with Adidas AG.

The Examiner takes the position that, "As the overshoe of Hoyt is stretched, the sides of the upper of the overshoe more tightly fit and take on the shape of the shoe in [sic-over] which they are being stretched around [sic], thereby allowing the protrusions of the shoe of WO '612 [Adidas AG] to aid in holding the overshoe onto the shoe." While this could be true if Hoyt disclosed a specific relationship between the width of the overshoe and the shoe in which it was to fit that would make this happen, Hoyt contains no such disclosure. Thus, this is mere speculation on the part of the Examiner. In fact, the teachings of Hoyt suggest that the exact opposite is true. In this regard, Hoyt contemplates that the overshoe can be stretched to accommodate shoes of several different sizes. See col. 2, lines 48-51 of Hoyt. Certainly, for the smaller sizes of these shoes of several different sizes, the sides of the Hoyt overshoe will not likely abut the outer surface of the shoe as the Examiner suggests, since relatively little stretching of the Hoyt overshoe would be required to accommodate the smaller sizes of the several different sizes that a particular Hoyt overshoe could be stretched to accommodate.

In addition, claim 32 requires that the outer surface of the protrusions of the removable

midsole section be formed by midsole. This limitation is also not taught or suggested by the combination of Adidas AG and Hoyt since the outer surface of the Adidas AG shoe, which, according to the Examiner, corresponds to the removable midsole section of claim 32, when contained in the Hoyt overshoe, is formed by either upper or bottom sole but not by midsole since the Adidas AG shoe has no outer surface formed by midsole. In other words, the midsole of Adidas AG is contained entirely within the upper and outsole of the Adidas AG shoe, and entirely within the Hoyt overshoe when the shoe of Adidas AG is in the Hoyt overshoe. As a result, the shoe of Adidas AG, when inserted in the overshoe of Hoyt as suggested by the Examiner, has no outer surface formed by midsole as claim 32 requires. Thus, Adidas AG in combination with Hoyt does not teach or suggest this feature of claim 32 of the present application either.

With respect to this issue, the Examiner takes the position that the insertion of the Adidas AG shoe into the overshoe of Hoyt somehow changes the outer sole of Adidas AG to midsole. See page 10, lines 4-13 of the Final Rejection. This argument is clearly wrong since it directly contradicts the teachings of Adidas AG that the outer sole is an outer sole and that a separate element, internal to the outersole, is the midsole. Thus, this argument should be disregarded.

Therefore, since at least two elements of claim 32 are missing from a combination of Hoyt with Adidas AG, the Examiner has not made out a case of *prima facie* obviousness and thus the rejection of claim 32 under 35 U.S.C. §103(a) over a combination of Adidas AG and Hoyt should be reversed for at least these reasons.

Group VII – Claims 33-38

The Examiner rejected claims 33-38 as unpatentable under 35 U.S.C. § 103(a) over Adidas AG in view of U.S. Patent no. 5,425,186 (Hoyt). In support of this rejection, the Examiner took the position that Adidas AG was to be applied to claims 33-38 as it was applied above in the anticipation rejection of claim 25, and thus concluded that Adidas AG teaches all limitations of claims 33-38 except for a shoe upper and a shoe sole.

The Examiner then relied on Hoyt as teaching that an overshoe, which consists of a shoe upper 32 and sole 12, 14, can cover a shoe. The Examiner then concluded that the overshoe can be placed over a shoe to protect it from wear and tear as well as inclement weather. From this, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to place the shoe of Adidas AG in the overshoe of Hoyt in order to arrive at the present invention, as claimed in claims 33-38.

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and Citations omitted]

Applying this requirement, at least three features of claims 33-38 are not found in a combination of Adidas AG with Hoyt, namely, (1) the plurality of protrusions on at least one side of the removable midsole section that are sized to interact with the shoe to retain the removable midsole section in the shoe, (2) that the outer surface of each of the plurality of

protrusions must be formed by midsole, and (3) that the at least two protrusions on the side of the removable midsole section are in abutting relationship with the bottom sole when the removable midsole section is inside the shoe, so that the protrusions occupy corresponding recesses in the bottom sole to thereby releasably retain said removable midsole section in said shoe.

With respect to missing elements (1) and (2), the same arguments given above with respect to claim 32 apply here and thus this rejection should be reversed on the basis that these elements of claims 33-38 are missing from the combination of Adidas AG and Hoyt.

In addition, claims 33-38 require that the at least two protrusions on the side of the removable midsole section are in abutting relationship with the bottom sole when the removable midsole section is inside the shoe, so that the protrusions occupy corresponding recesses in the bottom sole to thereby releasably retain said removable midsole section in said shoe.

The Examiner took the position, in relation to claim 33 that, "With respect to claims 33-34, the shoe upper 32 would abut at least a portion of the outer surface of the midsole (after midsole is placed within the overshoe)." First, this statement is incorrect as it applies to this rejection since, according to the Examiner, the shoe upper, as claimed in claims 33-38, is provided by the overshoe of Hoyt. As a result, when the shoe of Adidas AG is inserted into the overshoe of Hoyt, the upper of Hoyt will not abut the midsole of Adidas AG since the midsole of Adidas AG is contained entirely within the upper and outsole of the shoe of Adidas AG and thus has no exposed surface to abut with the upper of the overshoe of Hoyt.

Secondly, as discussed above, the Examiner has taken the position that in this combination of references, Hoyt provides the claimed bottom sole. Thus, the bottom sole of the

overshoe of Hoyt does not contain "corresponding recesses in the bottom sole" as required by claims 33-38. Thus, this additional element of claims 33-38 is completely missing from a combination of Adidas AG and Hoyt.

It should be noted that the Examiner cannot allege both that the outer sole of Adidas AG is the midsole of claims 33-38 and that the outer sole of Adidas AG provides the claimed "corresponding recesses in the bottom sole" since these two positions are clearly inconsistent. Either the outer sole of Adidas AG is an outer sole, as Adidas AG says it is, or it is a midsole, but it cannot be both for the convenience of the Examiner.

Therefore, since at least three elements of claims 33-38 are missing from a combination of Adidas AG and Hoyt, the applicant respectfully requests that the rejection of claims 33-38 under 35 U.S.C. §103(a) as being unpatentable over Adidas AG in view of Hoyt be reversed.

Issue 3: Whether Claims 12 and 13 are unpatentable under 35 U.S.C. §103(a) over Adidas AG in view of U.S. Patent Application 5,813,142 (Demon).

Group II - Claims 12-13

Claims 12-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adidas AG as applied to claim 11 above in view of U.S. Patent No. 5,813,142 (Demon). This rejection is respectfully traversed and reconsideration is requested for the following reasons.

The Examiner takes the position that,

"WO '127 [Adidas AG] discloses all of the limitations of the claim except for the compartment containing a fluid, a flow regulator, a duct, a control system that automatically adjusts the pressure in the compartment, and a microcomputer. Demon '142 teaches that a shoe sole can be modified to contain a compartment containing a fluid, a flow regulator, a duct, a control system automatically

adjusting the pressure in the compartment, and a microcomputer, substantially as claimed. Therefore, it would have been obvious to provide the shoe midsole of WO '127 [Adidas AG] with the system of Demon 142 to reduce the impact of the user's foot on the traveling surface during use."

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and citations omitted]

Claims 12-13 depend from claim 11. As discussed above with respect to the anticipation rejection of claim 11, Adidas AG does not teach the feature of claim 11 that the removable midsole section must be removable from the outer shoe. Demon also does not teach these features of claim 11. Accordingly, neither of the cited references teaches or suggests these features of claims 12-13 and thus claims 12-13 are clearly patentable over a combination of Adidas AG and Demon for at least this reason.

Further, the feature of claim 12 that requires the controller to be located in the inner shoe is not found in either Adidas AG or Demon. Adidas AG does not even disclose a controller. Demon teaches that the controller should be located in the shoe upper (See Fig. 1 of Demon). In regard to this point, the Examiner took the position that, "The claims only require that the controller be located in the inner shoe...since the controller of Demon is located within the shoe upper, since within the shoe upper is within the shoe, Demon meets this limitation in the claims."

Final Rejection at page 10, lines 15-18. This position of the Examiner demonstrates the flaw in the Examiner's logic since claims 12-13 require, in relevant part, that, "...the inner shoe is

removable from the shoe..." The upper of Demon is clearly not removable from the shoe and thus cannot form part of the inner shoe, as claimed in claims 12-13, as the Examiner suggests.

In addition, the present invention represents a non-obvious improvement over Adidas AG in view of Demon with respect to the location of the controller. Demon teaches that the controller 300 should be situated in the shoe's upper (see Figure 1) where it is exposed to the torsion created by the wearer during use. In the present invention, the controller is located within the inner shoe. Positioning the controller in the inner shoe greatly reduces the torsion problems associated with situating the controller in the shoe upper. Also, if the midsole section of Demon were made removable as the examiner suggests, it would be necessary to disconnect the controller prior to removing the midsole section since the controller 300 of Demon is located in the shoe upper.

Also, the controller in Demon is designed only to regulate the ambient air entering into and exiting from bladders located in the non-removable shoe sole. Therefore, one would have to modify the controller as taught in Demon to function in two different platforms: the inner shoe worn independently of the other parts of the shoe and the inner shoe worn as part of the complete shoe, in order to arrive at the present invention. There is no teaching or suggestion in either Adidas AG or Demon to do so.

Finally, the Examiner takes the position that it would be obvious to provide the shoe midsole of Adidas AG with the system of Demon to reduce the impact of the user's foot on the traveling surface during use. However, certain important features of the system of Demon would lead a skilled person away from combining the system of Demon with the shoe of Adidas AG.

The system of Demon is spread out over both the shoe sole and the shoe upper as shown in Fig. 1 of Demon. Therefore, the controller of Demon would reside in the upper 18 of Adidas AG and other elements of the system of Demon would reside in the midsole portion 12 of Adidas AG. As a result, there must be a connection between the control system in the upper 18 and the other elements in the midsole portion 12. This will make the shoe construction method of Adidas AG impractical since the shoe construction method of Adidas AG employs a midsole 12 that is a single integral piece that is separate from the upper 18. See e.g. Fig. 22 of Adidas AG. This is because it would be extremely difficult to provide the required connection between the upper and the midsole portion for the Examiner's combination of Adidas AG and Demon using the construction method of Adidas AG since separate portions of the connector would have to be fabricated in the upper and in the midsole portion. Moreover, there is very little contact between the midsole portion of Adidas AG and the upper, thereby limiting the locations where a suitable connection could be made, i.e. it appears from Figs. 20-26 of Adidas AG that a connection between the upper and the midsole portion could only be made in a small portion of the side of the forefoot portion of the midsole portion since otherwise it would be necessary for such a connection to pass through the outsole as well, thereby further complicating the manufacturing process.

The Examiner also took the position that all that is required in support of this obviousness rejection under 35 U.S.C. §103(a), "... is that the combination can be made..." Final Rejection, page 10 at line 21, emphasis added. That the Examiner's position is wrong can be clearly seen from MPEP §2143.01, subheading "FACT THAT REFERENCES CAN BE COMBINED OR

MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE OBVIOUSNESS*” which states, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’ *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432.).” The Examiner’s rejection lacks a suggestion or motivation in the reference to make the combination and modifications required to arrive at the present invention, as claimed, and thus the Examiner’s rejection should be reversed.

The present invention, therefore, clearly represents a non-obvious advancement in the art over Adidas AG in view of Demon. Accordingly, the applicant respectfully requests that the rejection of claims 12-13 under 35 U.S.C. §103(a) as being unpatentable over Adidas AG in view of Demon be withdrawn upon reconsideration.

Issue 4: Whether Claim 21 is unpatentable under 35 U.S.C. § 103(a) over WO 97/46127 (Adidas AG) in view of U.S. Patent no. 6,023,857 (Vizy et al.).

Group III – Claim 21

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Adidas AG as applied to claim 11 above in view of Vizy et al. This rejection is respectfully traversed and reconsideration is requested for the reasons, which follow.

The Examiner takes the position that,

“WO ‘127 [Adidas AG] discloses all of the limitations as claimed except for an

insole located within the midsole orthotic shoe [sic – removable midsole section]. Vizy et al. '857 teaches in column 1, lines 6-28 that is [sic] typical in a shoe to include an insole to aid in comforting the user's foot. Therefore, it would have been obvious, in view of Vizy et al. '857, to place an insole on top of the midsole of the WO '127 [Adidas AG] reference to aid in giving comfort to the user's foot during wear."

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and citations omitted]

Claim 21 depends from claim 11. As discussed above with respect to the anticipation rejection of claim 11, Adidas AG does not teach the feature of claim 11 that the removable midsole section must be removable from the outer shoe. Vizy et al. also does not teach this feature of claim 11 and the Examiner does not allege that Vizy et al. teaches this missing feature. Accordingly, neither of the cited references teaches or suggests this feature of claim 21 and thus claim 21 is clearly patentable over a combination of Adidas AG and Vizy et al. for at least this reason.

Accordingly, the applicant respectfully requests that the rejection of Claim 21 under 35 U.S.C. §103(a) as being unpatentable over Adidas AG in view of Vizy et al. be reversed.

Issue 5: Whether Claims 11-44 are unpatentable under 35 U. S.C. §101 as claiming the same invention as co-pending U.S. Application No. 09/558,629.

The Examiner has provisionally rejected Claims 11-44 under 35 U. S.C. §101 as claiming the same invention as co-pending U.S. Application No. 09/558,629 (Statutory Same-Invention Type Double Patenting). The Examiner has offered no evidence or arguments in support of this rejection. Thus, for this reason alone, the rejection should be reversed.

In copending U.S. Application No. 09/558,629 the Appellant is claiming an insertable midsole orthotic. In the specification of copending U.S. Application No. 09/558,629, the Appellant has defined the term "orthotic" in reference to midsoles as "corrective, therapeutic, prosthetic, or ... prescribed by health care professionals." (See e.g. page 1, lines 13-16, of the original specification of U.S. Application No. 09/558,629). The American Heritage Dictionary, 3d, defines the term "orthotic" as " the science that deals with the use of specialized mechanical devices to support or supplement *weakened or abnormal* joints or limbs" (emphasis added).

Although the term "orthotic" is a functional limitation, the Appellant emphasizes that it necessarily results in a *structural difference* in the claimed apparatus since an "orthotic" device must have structure designed specifically to support or supplement *weakened or abnormal* joints or limbs. In contrast, the claims of the present application are broader in scope in that they include any device including devices having structure to support or supplement the *normal, healthy* foot.

The Examiner has required the Appellant to either cancel the conflicting claims from all but one application *or* maintain a clear line of demarcation between the two applications. The

Appellant has fully complied with the latter by manifestly distinguishing the claims of the present application from the claims of co-pending Application No. 09/558,629 by claiming a removable midsole in the former and an insertable midsole orthotic in the latter.

Moreover, the Appellant notes that this rejection should only be made by the Examiner "should be used when the conflicting claims are identical or conceded by applicant to be not patentably distinct." *See* MPEP §822. In fact, in justifying his rejection, the Examiner has cited *In re Vogel*, 422 F.2d 438 (CCPA 1970). It is readily apparent by comparing the claims of U.S. Application No. 09/558,629 with the claims of the present application that the two sets of claims are not "identical." In fact, in paragraph 15 on page 8 of the Final Rejection, the Examiner admitted that the claims are not identical. Furthermore, the Appellant has never conceded that these two sets of claims are not patentably distinct. The court in *In re Vogel* clearly stated that the "same invention" requires "identical subject matter." *Id.* at 441. An "inner shoe" and an "insertable midsole orthotic" are clearly distinguishable for the reasons given above and, thus, the claims of the present application and the claims of U.S. Application No. 09/558,629 do not relate to identical subject matter. Therefore, the Appellant respectfully requests that the rejection of Claims 11-44 under 35 U.S.C. §101 be overturned.

Issue 6: Whether claims 11-44 are unpatentable over claims 11-45 of co-pending U.S. application no. 09/558,629 under the judicially-created doctrine of obviousness double patenting.

The Examiner alleges that claims 11-44 are obvious over claims 11-45 of co-pending U.S. Patent application no. 09/558,629. The entire basis of the Examiner's rejection found on page 8 of the Final Rejection is set forth below.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the terms "insertable" and "removable" are interchangeable. Since something that can be inserted can be removed and alternatively something that has been removed can certainly be replaced where it has been removed from, i.e. inserted, there appears to be no difference in the claimed subject matter.

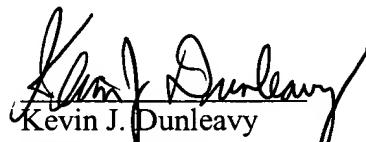
See page 8, paragraph 15 of the Final Rejection. From a review of the foregoing, it is immediately clear that the Examiner has not set forth a *prima facie* case of unpatentability over the claims of co-pending U.S. Patent application no. 09/558,629 since the rejection does not include the required claim by claim analysis sufficient to prove a *prima facie* case. As set forth in MPEP § 804(II)(B)(1), any obviousness-type double patenting rejection should make clear "the differences between the inventions defined by the conflicting claims . . . and . . . the reasons why a person of ordinary skill in the art would conclude the invention defined in the claim in issue is an obvious variation of the invention defined in the claim." The Examiner has not indicated the differences between the inventions defined by the conflicting claims nor has the Examiner given any reasons why a person of ordinary skill in the art would conclude that the subject matter defined in claims 11-44 of the present application is an obvious variation of the subject matter defined in the claims of co-pending U.S. Patent application no. 09/558,629. For example, all claims of co-pending U.S. Patent application no. 09/558,629 include the word, "orthotic" which has not been mentioned by the Examiner in the rejection.

Accordingly, for at least this reason, the obviousness-type double patenting rejection of claims 11-44 should be reversed.

IX. Conclusion

For the foregoing reasons, Appellant respectfully submits that each of the rejections should be reversed, that all claims be allowed. Such a decision is respectfully solicited.

Respectfully submitted,



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APPENDIX- CLAIMS ON APPEAL

11. An inner shoe which comprises:

 a removable midsole section sized to fit inside and form part of the sole of a shoe designed to receive and retain said removable midsole section;

 a secondary outer sole on at least a portion of the outer surface of the removable midsole section to provide traction or wear resistance when said inner shoe is worn without the shoe designed to receive and retain said removable midsole section;

 a device associated with the removable midsole section for retaining the inner shoe on an intended wearer's foot when worn without the shoe designed to receive and retain the removable midsole section; and

 wherein said inner shoe is removable from said shoe in order to wear said inner shoe independently of said shoe.

12. The inner shoe as claimed in claim 11, further comprising at least one computer controlled compartment, wherein the computer control for the computer controlled compartment is located in said inner shoe.

13. The inner shoe as claimed in claim 12, wherein the computer control is located in an upper portion of the removable midsole section.

14. The inner shoe as claimed in claim 11, wherein at least one portion of an outer surface of a side of the removable midsole section is concavely rounded relative to an inner section of the removable midsole section adjacent to the concavely rounded outer surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition.

15. The inner shoe as claimed in claim 14, wherein at least one portion of an inner

surface of a side of the removable midsole section is convexly rounded relative to a section of the removable midsole section adjacent to the convexly rounded inner surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition.

16. The inner shoe as claimed in claim 15, wherein each at least one convexly rounded inner surface portion and each at least one concavely rounded outer surface portion is located at a corresponding location on the removable midsole section to thereby form at least one concavely rounded side portion of the removable midsole section located between said convexly rounded inner surface portion and the concavely rounded outer surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition, said concavity of each said concavely rounded side portion being determined relative to a portion of the removable midsole section which is adapted to receive the foot of an intended wearer; and said at least one concavely rounded side portion is located at a location on the removable midsole section which corresponds to the position of at least one of the following parts of an intended wearer's foot when inside the removable midsole section: a base of a calcaneus, a lateral tuberosity of the calcaneus, a head of a first distal phalange, a longitudinal arch, a head of a first metatarsal, a head of a fifth metatarsal, and a base of the fifth metatarsal.

17. The inner shoe as claimed in claim 16, wherein a thickness of the removable midsole section tapers from a greater thickness measured at said at least one concavely rounded side portion to a lesser thickness at a location on one side of said concavely rounded side portion, as viewed in a horizontal plane when the removable midsole section is upright and in an unloaded condition.

18. The inner shoe as claimed in claim 17, wherein said thickness of the removable midsole section tapers to a lesser thickness on both sides of said concavely rounded side portion, as viewed in a horizontal plane when the inner shoe is upright and in an unloaded condition.

19. The inner shoe as claimed in claim 16, comprising at least two concavely rounded side portions and an indentation located between said two concavely rounded side portions, as viewed in a horizontal plane when the removable midsole section is upright and in an unloaded condition.

20. The inner shoe as claimed in claim 17, wherein each said concavely rounded side portion further comprises a concavely rounded portion of the outer surface of the removable midsole section, as viewed in a horizontal plane when the removable midsole section is upright and in an unloaded condition, said concavity of the concavely rounded portion of the outer surface being determined relative to an inner section of the removable midsole section directly adjacent to the concavely rounded outer surface portion.

21. The inner shoe as claimed in claim 11, further comprising an insole.

22. The inner shoe as claimed in claim 11, wherein said device is an inner shoe upper.

23. An outer shoe comprising:
an outer shoe upper and an outer shoe sole including at least a bottom sole;
at least a portion of said shoe sole being formed by an inner shoe as claimed in claim 11
when said inner shoe is inserted into said outer shoe;
at least a portion of the side of said outer shoe upper being attached directly to the bottom sole such that the shoe upper abuts at least a portion of the outer surface of the inner shoe when said inner shoe is inserted into the shoe; and
wherein said inner shoe is removable from the shoe and insertable into said shoe through an opening in the outer shoe upper provided for entry and exit of an intended wearer's foot into and out of said shoe.

24. An outer shoe as claimed in claim 23, wherein said inner shoe is releasably secured to said shoe by a releasable securing structure selected from the group consisting of mechanical fasteners, a snap fit, interlocking geometries and combinations thereof.

25. A removable midsole section sized to fit inside a shoe and form part of the shoe designed to receive and retain said removable midsole section, which comprises:

an inner surface and an outer surface which together define the removable midsole section having a lateral side, a medial side and a middle portion located between the lateral and medial sides;

a plurality of protrusions on at least one side of said removable midsole section, each of said protrusions having an outer surface formed by midsole, and wherein said protrusions are of sufficient size to interact with the shoe to retain said removable midsole section in said shoe;

at least one portion of the outer surface of each said protrusion is concavely rounded relative to an inner section of the removable midsole section adjacent to the concavely rounded outer surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition;

at least one portion of an inner surface of a side of the removable midsole section is convexly rounded relative to a section of the removable midsole section directly adjacent to the convexly rounded inner surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition; and

wherein said removable midsole section is removable from said shoe.

26. The removable midsole section as claimed in claim 25, wherein said at least one said protrusion is located on the lateral side of the removable midsole section and another of said protrusions is located on the medial side of the removable midsole section.

27. The removable midsole section as claimed in claim 25, wherein each at least one convexly rounded inner surface portion and each at least one concavely rounded outer surface

portion is located at a corresponding location on the removable midsole section to thereby form at least one of said protrusions.

28. The removable midsole section as claimed in claim 27, wherein each said protrusion is located at a location on the removable midsole section which corresponds to the position of at least one of the following parts of an intended wearer's foot when inside the removable midsole section: a base of a calcaneus, a lateral tuberosity of the calcaneus, a head of a first distal phalange, a longitudinal arch, a head of a first metatarsal, a head of a fifth metatarsal, and a base of the fifth metatarsal.

29. The removable midsole section as claimed in claim 28, wherein a thickness of the removable midsole section tapers from a greater thickness measured at each said protrusion to a lesser thickness at a location on one side of each said protrusion, as viewed in a horizontal plane when the removable midsole section is upright and in an unloaded condition.

30. The removable midsole section as claimed in claim 29, wherein the thickness of the removable midsole section tapers to a lesser thickness on both sides of each said protrusion, as viewed in a horizontal plane when the removable midsole section is upright and in an unloaded condition.

31. The removable midsole section as claimed in claim 27, further comprising an indentation located between said two protrusions, as viewed in a horizontal plane when the removable midsole section is upright and in an unloaded condition.

32. An outer shoe comprising:
an outer shoe upper and an outer shoe sole including at least a bottom sole;
at least a portion of said outer shoe sole being formed by an removable midsole section as claimed in claim 25;

at least a portion of the side of said outer shoe upper being attached directly to the bottom sole such that the outer shoe upper abuts at least a portion of the outer surface of the removable midsole section when said removable midsole section is inserted into the shoe; and

wherein said removable midsole section is removable from the shoe and insertable into said shoe through an opening in the outer shoe upper provided for entry and exit of an intended wearer's foot into and out of said shoe.

33. An outer shoe as claimed in claim 32, wherein the at least two protrusions on the side of the removable midsole section are in abutting relationship with the bottom sole when the removable midsole section is inside the shoe, so that the protrusions occupy corresponding recesses in the bottom sole to thereby releasably retain said removable midsole section in said shoe.

34. An outer shoe as claimed in claim 33, wherein a thickness of the removable midsole section tapers from a greater thickness measured at one said protrusion to a lesser thickness at a location on one side of said protrusion, as viewed in a horizontal plane when the removable midsole section is upright and in an unloaded condition.

35. An outer shoe as claimed in claim 34, wherein at least one portion of the outer surface of a side of the removable midsole section is concavely rounded relative to an inner section of the removable midsole section adjacent to the concavely rounded outer surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition.

36. An outer shoe as claimed in claim 35, wherein at least one portion of an inner surface of a side of the removable midsole section is convexly rounded relative to a section of the removable midsole section adjacent to the convexly rounded inner surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded

condition.

37. An outer shoe as claimed in claim 36, wherein each at least one convexly rounded inner surface portion and each at least one concavely rounded outer surface portion is located at a corresponding location on the removable midsole section to thereby form at least one of said protrusions.

38. An outer shoe as claimed in claim 37, wherein each said protrusion is located at a location on the removable midsole section which corresponds to the position of at least one of the following parts of an intended wearer's foot when inside the removable midsole section: a base of a calcaneus, a lateral tuberosity of the calcaneus, a head of a first distal phalange, a longitudinal arch, a head of a first metatarsal, a head of a fifth metatarsal, and a base of the fifth metatarsal.

39. An outer shoe for receiving a removable midsole section which comprises:
an outer shoe upper and an outer shoe sole including at least a bottom sole;
at least a portion of the side of said outer shoe upper being attached directly to the bottom sole such that the outer shoe upper abuts at least a portion of the outer surface of the removable midsole section when said removable midsole section is inserted into the outer shoe;
wherein said removable midsole section is removable from the outer shoe and insertable into said outer shoe through an opening in the shoe upper provided for entry and exit of an intended wearer's foot into and out of said outer shoe; and
at least two recesses in the bottom sole to thereby releasably retain said removable midsole section in said outer shoe.

40. An outer shoe as claimed in claim 39, wherein the outer surface of the bottom sole further comprises a plurality of protrusions on at least one side of said bottom sole;

at least one portion of the outer surface of each said protrusion on said bottom sole is concavely rounded relative to an inner section of the bottom sole directly adjacent to the concavely rounded outer surface portion, as viewed in a frontal plane cross-section when the bottom sole is upright and in an unloaded condition; and

at least one portion of an inner surface of a side each said protrusion of said bottom sole is convexly rounded relative to a section of the bottom sole directly adjacent to the convexly rounded inner surface portion, as viewed in a frontal plane cross-section when the bottom sole is upright and in an unloaded condition.

41. An outer shoe as claimed in claim 40, wherein said at least one said protrusion is located on the lateral side of the bottom sole and another of said protrusions is located on the medial side of the bottom sole.

42. An outer shoe as claimed in claim 40, wherein each said protrusion is located at a location on the bottom sole which corresponds to the position of at least one of the following parts of an intended wearer's foot when inside the removable midsole section: a base of a calcaneus, a lateral tuberosity of the calcaneus, a head of a first distal phalange, a longitudinal arch, a head of a first metatarsal, a head of a fifth metatarsal, and a base of the fifth metatarsal.

43. An outer shoe as claimed in claim 42, wherein a thickness of the bottom sole tapers from a greater thickness measured at each said protrusion to a lesser thickness at a location on one side of each said protrusion, as viewed in a horizontal plane when the bottom sole is upright and in an unloaded condition.

44. An outer shoe as claimed in claim 43, wherein the thickness of the bottom sole tapers to a lesser thickness on both sides of each said protrusion, as viewed in a horizontal plane when the bottom sole is upright and in an unloaded condition.



AF/3728

PATENT
Attorney Docket No. ANAT-1015US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Frampton E. Ellis, III)
Application No.: 09/527,019) Group Art Unit: 3728
Filed: March 16, 2000) Examiner: Anthony Stashick
For: Removable Rounded Midsole)
Structures And Chambers With)
Computer Controlled Processor-)
Controlled Variable Pressure)

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 Check in the amount of \$320.00 for the filing of an Appeal Brief.

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Certificate of Mail Under 37 CFR 1.8

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I hereby certify that this paper, along with any document or paper referred to as being attached, is being deposited with the United States Postal Service as first class mail under 37 CFR 1.8 on the date indicated above and is addressed to the Commissioner for Patents, Mailstop Appeal Briefs Patents, Washington, D.C. 20231.

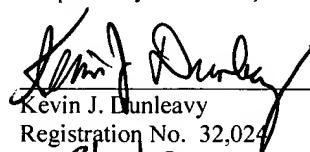
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Respectfully submitted,


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